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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,554	12/22/1999	DANIEL I. KERPELMAN	GEMS:0066/15	6296

7590

01/23/2003

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EXAMINER

MORGAN, ROBERT W

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,554

Applicant(s)

KERPELMAN ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on November 18, 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This communication is in response to the request for reconsideration filed 11/18/02.

Claims 1-32 are presented for examination.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 and 15-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,021 to Wong et al. in view of U.S. Patent No. 5,867,821 to Ballantyne et al., for the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

4. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,021 to Wong et al. in view of U.S. Patent No. 5,867,821 to Ballantyne et al., as applied to claim 1 above, and further in view of Official Notice, for the same reasons given in the previous Office Action (paper number 6). Further reasons appear below.

***Response to Arguments***

5. Applicant's arguments filed 11/18/02 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 11/18/02.

(A) In the remarks, Applicants argue in substance that, (1) obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent

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some teaching or suggestion supporting the combination; (2) the Examiner has misconstrued the references and applied some basic assumptions that are unsupported by the reference; (3) the proposed combination of references fails to include at least one of the recited elements such as “a service request”, “a data communication control system coupled to a plurality of diagnostic systems”, and “a plurality of medical diagnostic system coupled to an internal network; (4) the Examiner has failed to provide support for a motivation or suggestion to combine the reference and (5) Applicant is requesting the Examiner provide support under M.P.E.P. § 2144.03 for the assertion of what is “well known in the art” regarding the step of “placing the service request in a queue, and transmitting the service request in accordance with an established schedule”.

(B) In response to Applicant arguments that, (1) the burden of establishing a *prima facie* case of obviousness fails on the Examiner and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant’s claimed invention (see: paper number 6).

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In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (paper number 7), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(C) In response to Applicant arguments that (2) the Examiner has misconstrued the references and applied some basic assumptions that are unsupported by the reference. The

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Examiner respectfully submits that Wong et al. teaches that the clients systems are connected via a network links (36, Fig. 1) that implements TCP/IP suite of protocols, and accordingly, can be campus intranet, a wide-area intranet, or even the Internet (see: column 8, lines 53-64). The Examiner also directs the Applicant's attention to Fig. 1 and item referenced by numeral 36, which clearly indicates that the network is not only the Intranet which a form of an internal network but also the Internet a form of an external network.

In addition, Wong et al. teaches a client system such as system (38, Fig. 1) that presents graphical user interfaces ("GUI") which health-care personal use to request and view medical images (see: column 8, lines 53-64). Furthermore, the network-attached client workstations are configured with an object-oriented graphical interface for receiving medical image request form a user and transmitting the requested medical image object to the requesting graphical interface (see: column 3, lines 61 to column 4, lines 15). The Examiner also notes that the features upon which the Applicant relies (i.e., medical diagnostic imaging system such as MRI, ultrasound, CT and X-ray) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(D) In response to Applicant arguments that (3) the proposed combination of references fails to include at least one of the recited elements such as "a service request", "a data communication control system coupled to a plurality of diagnostic systems", and "a plurality of medical diagnostic system coupled to an internal network.

The Examiner respectfully submits that the Wong et al. reference, and not Ballantyne, *per se*, that was relied upon for the specific teaching of a **network-attached client workstations** that

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are configured with an object-oriented graphical interface for receiving **medical image request from a user** and transmitting the requested medical image object to the requesting graphical interface (see: column 3, lines 61 to column 4, lines 15). Ballantyne et al. was relied on for primarily teaching of a communication controller (26, Fig. 2) (data communication control system), which is responsible for all data routing information between the internal network and the Hospital information network (see: column 5, lines 6-23). Thus, the proper combination of the applied references would be the incorporation of Ballantyne et al. the communication controller within the medical image distribution system of Wong et al.

(E) In response to Applicant arguments that (4) the Examiner has failed to provide support for a motivation or suggestion to combine the reference. The Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 6). In addition, the Examiner respectfully submits that the motivation to combine the applied references is supported by motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is

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NOT seen that the Examiner's has failed to provide support for a motivation or suggestion to combine the reference. Rather, it is respectfully submitted that explanation is based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

(F) In response to Applicant arguments that (5) Applicant is requesting the Examiner provide support under M.P.E.P. § 2144.03 for the assertion of what is "well known in the art" regarding the step of "placing the service request in a queue, and transmitting the service request in accordance with an established schedule". The Examiner hereby directs Applicant's attention to U.S. Patent No. 4,982,325 to Tignor et al. (cited herewith), which clearly evidences the use of sending a service requests to a queue and transmitting of the service request according to a schedule as far back as 1991, more than seven years prior to the filing of Applicant's present application (note especially col. 10, lines 52-55 of Tignor e al.). As such, the knowledge and use of placing service requests in a queue, and transmitting the service request in accordance with an



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established schedule, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention.

*In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the

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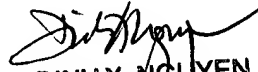
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organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM  
rwm  
January 21, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER